

RECEIVED
CENTRAL FAX CENTER

JAN 24 2007

REMARKS/ARGUMENTS

I. STATUS OF THE PENDING CLAIMS

Claim 15 is the only claim pending in the application. Claim 15 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over JP 2003334149 ("JP1") in view of JP 2002165729 ("JP2"). The specification has been amended non-substantively to correct minor typographical errors. No new subject matter has been added by any amendment herein.

**II. REJECTION UNDER 35 U.S.C. § 103(a) OVER
JP 2003334149 AND JP 2002165729**

Claim 15 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over JP1 in view of JP2.

A rejection under 35 U.S.C. § 103(a) requires the establishment of a *prima facie* case that the claimed subject matter, including all claim elements, would have been obvious to a person of ordinary skill in the art on the basis of either a single prior art reference or more than one reference which are properly combinable. Applicant submits that no such *prima facie* case of unpatentability has been established for claim 15, and respectfully traverses the rejection of the claim on the basis of the following arguments.

1. There is no inherency in JP1 or JP2 of a method of training a toddler.

The Examiner relies on inherency to reject the method of claim 15. An allegedly inherent characteristic of a reference is one that is necessarily, not merely possibly, present. *Continental Can Co. USA, Inc. v. Monsanto Co.*, 948 F.2d 1264, 1268-69 (Fed. Cir. 1991). "The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient." *Id.* at 1269.

According to the Examiner, "[t]he method for training a toddler to urinate into the toilet would be inherently performed during the normal use of [JP1 in view of JP2]." First, this is a misapplication of the inherency doctrine. Although it is well established that inherency is

applicable both to an anticipation and obviousness analysis, *In re Napier*, 55 F.3d 610, 613 (Fed. Cir. 1995), the allegedly inherent disclosure in the context of obviousness can only be one that is necessarily present in a standalone reference, not to the combined references as a whole. *See id.* at 613 (affirming an application rejection based on obviousness that was dependent upon the inherent characteristic of one of the references prior to that reference being combined with another). Second, even assuming *arguendo* that Examiner's allegation of inherency is valid, the cited references, whether alone or in combination, in no way necessarily result in the training of anyone or anything, let alone the specific training of a toddler to use a toilet. In fact, neither of the available Abstracts of JP1 or JP2 discusses any form of training whatsoever, further emphasizing the Examiner's failure to establish a *prima facie* case of obviousness.

2. The claimed method is not inherently disclosed by prior art apparatuses.

The Examiner also errs in attempting to invalidate method claim 15 on the basis of the combined disclosures of two prior art apparatuses. Although a prior art apparatus may disclose a related method, "a process [cannot] be anticipated by showing a prior art apparatus which could have been used for the process, where the prior art fails to teach that process." *Karl Kiefer Mach. Co. v. U.S. Bottlers Mach. Co.*, 114 F.2d 169 (7th Cir. 1940) (citing, *inter alia*, *Carnegie Steel Co. v. Cambria Co.*, 185 U.S. 403 (1902)). Specifically, JP1 and JP2 fail to disclose claim 15's specific method steps of "instructing [a] toddler to stand on the liquid absorbent matting," "communicating to the toddler the relationship between the perceptible indication on the liquid absorbent matting and urinating other than into the toilet orifice," or "instruct[ing the toddler] to stand on the footprints in order to be suitably positioned with respect to the toilet." There is nothing in either Abstract to suggest any of these steps, let alone their application to a toddler.

3. JP1 and JP2 do not disclose a disposable toilet mat.

Applicant further submits that the Examiner has incorrectly understood the term "disposable" as used in the instant specification. Claim 15 recites a method for placing a *disposable* liquid-absorbent matting in proximity to a base of a toilet. JP1 and JP2 do not disclose a toilet mat comprising matting which meets the claim limitation that it be *disposable*.

The word "disposable" as recited in the claims has a clear, universally accepted meaning. According to Merriam-Webster [[http:// www.m-w.com](http://www.m-w.com) (disposable)]:

“Main Entry: **dis·pos·able**

Pronunciation: di-'spO-z&-b&l

Function: *adjective*

1 : subject to or available for disposal; *specifically* : remaining to an individual after deduction of taxes and necessary living expenses <*disposable income*>

2 : *designed to be used once and then thrown away* <*disposable diapers*>”

Merriam-Webster provides two definitions of the word “disposable”. The first refers to disposable income, a concept plainly not involved in the claims. The second definition, however, squarely fits the usage in the claims: “designed to be used once and then thrown away.” The example of disposable diapers underscores that this second definition is on point.

Applicant has not used or defined the term “disposable” in any manner that conflicts with or is in any way contradicted by its plain meaning as discussed above.

The Examiner alleges that “[JP1] discloses a *disposable* liquid-absorbent matting in proximity to the toilet base.” This assertion is flatly contradicted by the demonstrated plain meaning of “disposable”, as well as the usage of “disposable” in the application and the claim.

The Examiner may be mistaking “disposable” with replaceable. These terms, however, are directed to distinct concepts. An object can be replaceable without being disposable, as that word is correctly understood. Nothing in JP1 suggests using a disposable material, and JP2 is entirely silent regarding the reusability of the disclosed mat. The toilet mats disclosed in these references may very well be reused any number of times and replaced merely for purposes of cleaning or reconditioning.

The distinction over JP1 is also clear from the fact that, as the present application clearly explains, disposability involves structural features, e.g. “any material intended to be used until soiled, that is, a small number of time[s], or [even] a single time, single-use or otherwise

FROM W&C LLP 19TH FL.

Application No. 10/821,716, filed April 9, 2004
Attorney Docket No.: 1119309-0006
Page 6 of 6

(WED) 1. 24' 07 19:06/ST. 19:04/NO. 4260454327 P. 6

RECEIVED
CENTRAL FAX CENTER

JAN 24 2007

disposable, as distinguished from a mat or rug of fabric that wouldn't ordinarily be intended to be used only once or a small number of times until soiled." (Application p. 4, ll. 20-24.)

Furthermore, "the material, or materials are ... most preferably disposable materials, as opposed to ... material used in those toilet mats that are known in the art for repeated, indefinite use." (*Id.* at p. 5, ll. 7-10.)

Accordingly, the present invention is not disclosed or suggested by JP1 or JP2, whether alone or in combination. Consequently, Applicant respectfully submits that at least for the reasons discussed above, pending claim 15 recites allowable subject matter.

CONCLUSION

Applicant submits that pending claim 15 is patentably distinguishable over the art of record.

The Commissioner is authorized to charge any fees required to maintain pendency of the above-captioned application to Deposit Account No. 23-1703.

Dated: January 24, 2007

Respectfully submitted,

/Andrew Fessak/

Reg. No. 48,528

Customer No. 007470

Direct Dial: (212) 819-8437